

REMARKS/ARGUMENTS

Claims 35-39 and 42-45 are pending and under examination. Claims 40 and 41 have been canceled. New claim 45 has been added.

Claim amendments

Claim 44 has been amended to remove the recitation of nucleotides 137-196.

Support for new claim 45 can be found in previous claim 37. No new matter is added by this amendment.

These amendments are made without prejudice to the filing of a continuation or continuation-in-part application directed to the canceled subject matter.

Allowable Subject Matter

Claims 38 and 39 were found allowable.

Claims 42 and 43 were objected to as being dependent on a rejected base claim (44). The Examiner indicated that claims 42 and 43 were considered free of the prior art since the prior art does not teach or fairly suggest a pharmaceutical composition comprising a polynucleotide in a pharmaceutically acceptable carrier, wherein the polynucleotide

- (a) has a sequence of at least 7 nucleotides that specifically hybridizes to the first nucleotide sequence within an accessible region of the RNA component of a human telomerase (hTR), wherein the accessible region is selected from the group consisting of nucleotides 290-319 and nucleotides 350-380 of hTR (SEQ ID NO:16),
- (b) does not hybridize to a second nucleotide sequence within the template region of the hTR, said template region being nucleotides 46-55 of SEQ ID NO:16, and
- (c) is effective to inhibit the synthesis of telomeric DNA by telomerase.

Claim Rejections 35 USC 102/103

Claims 35, 36, 40, 41 and 44 stand rejected under 35 U.S.C. 102(e) or 35 U.S.C. 103(a) as being anticipated by or obvious over Villeponteau et al. Villeponteau et al. allegedly disclose a stand alone PCR primer that contains nucleotides 145-166 of SEQ ID NO:16. The PCR primer disclosed by Villeponteau et al., allegedly would specifically hybridize to the accessible region of nucleotides 137-196 of Applicant's invention. Furthermore, Villeponteau et al., allegedly disclose that the nucleic acids (e.g. primers) of their invention are useful as pharmaceutical, therapeutic and diagnostic reagents (See Abstract). It is the Examiner's position that the PCR primer disclosed by Villeponteau et al., was synthesized and resuspended in some type of wetting agent for example water, since the primer was later added to a PCR reaction solution.

Applicants continue to maintain that the claims as recited are patentable for the reasons recited in previous responses. However, in order to expedite prosecution and to present clearly allowable subject matter, Applicant has amended claim 44 to delete the recitation of nucleotides 137-196 without prejudice. The Examiner has indicated that claim 44 with this amendment would be allowable. Claims 35, 36, 37, depend from amended claim 44. Applicants have canceled claims 40 and 41, rendering the rejection of these claims moot. Withdrawal of this rejection is respectfully requested.

Claims 37 and 44 stand rejected under 35 U.S.C. 103(a) as being anticipated by Villeponteau et al., in view of Nakamaye et al., (Nucleic Acids Research 1988 vol. 16: 9947-9959). Villeponteau et al. has already been discussed. Nakamaye et al., allegedly teach an alternative method for direct sequencing of DNA generated by Taq polymerase-PCR via the incorporation of phosphorothioate nucleotides and followed by treatment with alkylating agents.

As discussed previously, Claim 44 (as amended) is no longer anticipated by Villeponteau et al. Nakamaye et al., does not teach or suggest an oligonucleotide capable of hybridizing to region 137-196 of hTR. Claim 37 is dependent on claim 44 and includes all of the limitations of claim 44. Accordingly, claims 37 and 44 are not anticipated by Villeponteau et al. in view of

Nakamaye et al. For these reasons, Applications respectfully request that the Examiner withdraw the rejection under 35 U.S.C. 103(a).

CONCLUSION

For the reasons provided above, Applicants respectfully request that all of the rejection be withdrawn and a Notice of Allowance issued.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account Number 07-1139.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-566-7106.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Leslie Mooi', is written over a light gray rectangular background.

Leslie Mooi

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